



Attorney's Docket No. 003300-293

H875
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)
PER HOFVANDER, et al.)
Serial No.: 08/070,455) Group Art Unit: 1804
Filed: June 9, 1993) Examiner: David T. Fox
For: GENETICALLY ENGINEERED)
MODIFICATION OF POTATO TO)
FORM AMYLOPECTIN-TYPE)
STARCH)

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GROUP 1800

RESPONSE

Honorable Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

In complete response to the December 30, 1993 Official Action, Applicants elect with
traverse the claims of Group I (i.e., Nos. 1 and 4 to 20) for immediate prosecution.

The reconsideration of the requirement for restriction respectfully is requested.

It respectfully is submitted that the subject matter of all claims could be conveniently
examined in the same application. It is expressly stated in Claims 2 and 3 that the amylopectin-type
natural starch is obtained from or extracted from a "potato which has been modified in a genetically
engineered manner". A thorough search of the claimed subject matter of the claims of Groups I and
II would be expected to encompass the same areas. It is urged that the examination of Claims 1 to
20 should not be considered to be unduly burdensome and that the same search would be required even
if the claims of only one Group were examined.

It further is pointed out that the present application was filed in the United States pursuant
to the terms of the Patent Cooperation Treaty. The terms of such treaty are fully binding upon the
actions of the U.S. Patent and Trademark Office as a matter of law. Unity of invention with respect
to all claims already has been found during the examination of International Application

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PCT/SE91/00892.

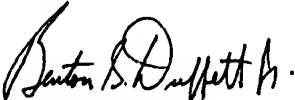
Please see the decision of the U.S. District Court of the Eastern District of Virginia, Caterpillar Tractor Co. v. Commissioner of Patents and Trademarks, 231 U.S.P.Q. 590, (E.D. Va. 1986). Therein, it was found that the Patent and Trademark Office's requirement of restriction in an application filed under the Patent Cooperation Treaty was contrary to law.

In view of the foregoing factors, it is urged that the requirement for restriction between the claims of Group I and II is improper, and that all of Claims 1 to 20 are properly examinable in the present application. Accordingly, withdrawal of the requirement for restriction is urged to be in order and is thus respectfully requested.

From the foregoing reasons, substantive action on the merits of all claims of record hereby is respectfully requested.

Respectfully submitted,

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